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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/605,696	10/21/2003	James P. Wheatman	A3-1672	2695
27127	7590	10/14/2004	EXAMINER	
HARTMAN & HARTMAN, P.C. 552 EAST 700 NORTH VALPARAISO, IN 46383			JEFFERY, JOHN A	
			ART UNIT	PAPER NUMBER
			3742	

DATE MAILED: 10/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/605,696

Applicant(s)

WHEATMAN, JAMES P.

Examiner

John A. Jeffery

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION***Drawing Objections***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the raised pattern on the roller surface in claims 2 and 3 must be shown or the feature(s) canceled from the claim(s). See, e.g., Para. 0015 of the specification (stating that the raised pattern is not shown). Applicant is reminded to amend the specification accordingly in conjunction with the drawing change. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the

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applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 USC 102(b) as being anticipated by Halpern (US2474312). Halpern (US2474312) discloses in Fig. 2 a ceramic heated tool with a "raised pattern" 4 heated by NiCr heater wire 2 to a temperature of about 800° C (inherently sufficient to burn wood if contacted with wood). See col. 1, lines 42-46 and col. 3, lines 42-45.

Claim Rejections - 35 USC § 102 or 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

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Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Gottschild (US4795076) or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Gottschild (US4795076) in view of DE2529273. Gottschild (US4795076) discloses in Fig. 2 a ceramic heating tool comprising a "raised pattern" (ceramic pointed tip 1') and an electric heating element 8 embedded within the tip adjacent thereto. While the tool is used for soldering and not burning a wood surface, the temperature generated by the tool to accomplish soldering is inherently capable of burning a pattern in a wooden surface if the tip is applied to a wood surface.

If such inherency is disputed, then Applicant is referred to DE2529273 where a soldering iron is expressly stated in the abstract as being usable for not only soldering, but also burning patterns or marks on wood. To be capable of such use, the heat generated by the soldering iron must be sufficient to burn the wood. Note that the different tips in DE2529273 are "heated to the same temperature." In view of the auxiliary use of a soldering iron for burning marks or patterns on wood, it would have been obvious to one of ordinary skill in the art to provide an electric heater in the soldering iron of Gottschild (US4795076) sufficient to burn patterns on wood so that the iron was able to perform additional uses not limited to soldering.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Staller (US3136878) or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Staller (US3136878) in view of DE2529273. Staller (US3136878) discloses a soldering iron with ceramic tip with "raised pattern" and electric heating element embedded

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therein. See Figs. 1 and 4. See also col. 1, lines 52-65 for an explanation of the advantage of using a ceramic tip over a conventional metallic tip. While the tool is used for soldering and not burning a wood surface, the temperature generated by the tool to accomplish soldering is inherently capable of burning a pattern in a wooden surface if the tip is applied to a wood surface.

If such inherency is disputed, then Applicant is referred to DE2529273 where a soldering iron is expressly stated in the abstract as being usable for not only soldering, but also burning patterns or marks on wood. To be capable of such use, the heat generated by the soldering iron must be sufficient to burn the wood. Note that the different tips in DE2529273 are "heated to the same temperature." In view of the auxiliary use of a soldering iron for burning marks or patterns on wood, it would have been obvious to one of ordinary skill in the art to provide an electric heater in the soldering iron of DE2529273 sufficient to burn patterns on wood so that the iron was able to perform additional uses not limited to soldering.

Claim Rejections - 35 U.S.C. § 103(a)

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Colledge (US 4,007,767) in view of Hyllberg (US 5,616,263). Colledge (US 4,007,767) discloses an electrically heated roller 23 with raised pattern 32 that burns a pattern in wood workpiece 31. See Fig. 1 and col. 4, lines 15-54. The claims differ from the previously cited prior art in calling for the roller to be formed of a ceramic material. Providing ceramic rollers, however, is well known in the art. Hyllberg (US 5,616,263),

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for example, discloses an electrically-heated ceramic roller whose outer layer can be ceramic in lieu of metal. See last line of abstract and Figs. 1, 2. As is known in the art, ceramic materials are electrically insulating, yet exhibit excellent heat conductivity. In view of Hyllberg (US 5,616,263), it would have been obvious to one of ordinary skill in the art to use a ceramic material for the roller of the previously described apparatus to form the roller from a material that was electrically insulating, yet highly heat conductive.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Halpern in view of Nakagawa et al (US 5,502,967). The claim differs from the previously cited prior art in calling for the ceramic body to be a roller. Forming ceramic tips of electrically-heated tools in the form of rotary members, however, is well known in the art. Nakagawa et al (US 5,502,967), for example, discloses in col. 6, lines 61-63 that the heat application tip 4 can be a rotary member such as a ball. Also, the tip 4 can be ceramic material. Col. 6, lines 57-59. As is known in the art, rotary heat application tips reduce friction as compared to non-rotary members. In view of Nakagawa et al (US 5,502,967), it would have been obvious to one of ordinary skill in the art to provide a rotary heat application tip in lieu of the non-rotary tips of the previously described apparatus to reduce friction, thus more smoothly applying heat to the workpiece as compared to a non-rotary tip.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gottschild (US4795076) in view of Nakagawa et al (US 5,502,967), or, alternatively, Gottschild

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(US4795076) in view of DE2529273 and further in view of Nakagawa et al (US 5,502,967). The claim differs from the previously cited prior art in calling for the ceramic body to be a roller. Forming ceramic tips of electrically-heated tools in the form of rotary members, however, is well known in the art. Nakagawa et al (US 5,502,967), for example, discloses in col. 6, lines 61-63 that the heat application tip 4 can be a rotary member such as a ball. Also, the tip 4 can be ceramic material. Col. 6, lines 57-59. As is known in the art, rotary heat application tips reduce friction as compared to non-rotary members. In view of Nakagawa et al (US 5,502,967), it would have been obvious to one of ordinary skill in the art to provide a rotary heat application tip in lieu of the non-rotary tips of the previously described apparatus to reduce friction, thus more smoothly applying heat to the workpiece as compared to a non-rotary tip.

Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Staller (US3136878) in view of Nakagawa et al (US 5,502,967), or, in the alternative, Staller (US3136878) in view of DE2529273 and further in view of Nakagawa et al (US 5,502,967). The claim differs from the previously cited prior art in calling for the ceramic body to be a roller. Forming ceramic tips of electrically-heated tools in the form of rotary members, however, is well known in the art. Nakagawa et al (US 5,502,967), for example, discloses in col. 6, lines 61-63 that the heat application tip 4 can be a rotary member such as a ball. Also, the tip 4 can be ceramic material. Col. 6, lines 57-59. As is known in the art, rotary heat application tips reduce friction as compared to non-rotary members. In view of Nakagawa et al (US 5,502,967), it would have been obvious to

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one of ordinary skill in the art to provide a rotary heat application tip in lieu of the non-rotary tips of the previously described apparatus to reduce friction, thus more smoothly applying heat to the workpiece as compared to a non-rotary tip.

Other Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant should (1) separately consider the art, and (2) consider the art together with the previously cited prior art for potential applicability under 35 U.S.C. §§ 102 or 103 when responding to this action. JP 202, DE 266, CH 481, US 111 disclose heated rollers for burning patterns in wood. US 267 discloses ceramic electrically-heated rollers. US 562 US 477, JP 124, JP 477, US 543, US 951, US 772 disclose electrically heated tools relevant to the instant invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John A. Jeffery whose telephone number is (703) 306-4601. The examiner can normally be reached on Monday - Thursday from 7:00 AM to 4:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robin Evans, can be reached on (703) 305-5766. All faxes should be sent to the centralized fax number at (703) 872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free)

A handwritten signature in black ink, appearing to read "John A. Jeffery". The signature is fluid and cursive, with the first name "John" being the most prominent.

**JOHN A. JEFFERY
PRIMARY EXAMINER**

9/15/04